

REMARKS/ARGUMENTS

In the Office Action, claim 22 was rejected under 35 U.S.C. § 112, second paragraph, for omitting an essential element, claims 2, 4, 6, 8-12 and 22 were rejected under 35 U.S.C. § 102(e) as being anticipated by US Publication No. 2003/0154135 to Covington et al. (“**Covington**”), claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over **Covington** in view of the Communications Today article, PTO-892, Item U (“**Communications Today**”), and claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over **Covington** in view of US Patent No. 5,862,325 to Reed et al. (“**Reed**”). By the present response, Applicant has amended claims 2, 4, 6-8, 22 and 23, and has added claims 24 and 25. Thus, claims 2, 4, 6-12 and 22-25 are pending.

As explained in the specification, Applicant’s invention is directed to a method for providing information to a user at a remote portable device (e.g., PDA) whereby information items (from an on-line directory website) may be accessed using the robust browsing capabilities of a personal computer, then downloaded to the portable device when it is in a location having a direct communication link to the computer, and then accessed and used at the portable device when at a location away from the computer.

Applicant has amended the claims to more clearly recite the invention and distinguish the claims from the cited references. For example, in independent claim 22, Applicant now recites a “method for providing information items from an on-line directory website to a user at a remote portable device,” including the steps of “accessing the information items at the directory website . . .,” “placing the information items in an information shopping cart at the website . . .,” “transmitting the information shopping cart having the selected information items from the website to the portable device when the portable device is in direct communication with the computer,” and “using the portable device to access the selected information items when the portable device is at a remote location away from the computer and not in direct communication with the computer.” In the preamble, Applicant further recites the

environment of the portable device and the computer (as is disclosed in the drawings and specification), for example, the computer "communicating directly with the portable device when the portable device is at the location of the computer", and the portable device useable "at remote locations away from the computer where not in direct communication with the computer".

Independent claim 23 has been amended to recite similar and additional limitations.

Covington, the principal reference relied upon by the Examiner, shows a system where a user may create a wish list or shopping cart of desired products (i.e., a wish list of gifts), by using a PC 28 to access a shopping website portal 30. The user (the person creating the wish list) and a potential shopper buying gifts for the user may each go to a store or mall where the items are displayed and use a PDA 20. The user may use the PDA to add to the wish list at the store, and the shopper buying for the user may use the PDA at the store to identify and facilitate the purchase of items on the wish list.

Unlike Applicant's invention, the items on the wish list in **Covington** are not information items accessed at an on-line directory website (as recited in independent claim 22). Furthermore, **Covington** does not disclose accessing the information items using a computer, and transmitting the information items in the shopping cart to the portable device "when the portable device is at the location of the computer and in direct communication with the computer," and then using the information items at the portable device "when the portable device is at a remote location away from the computer and not in direct communication with the computer," as also recited in claim 22.

In **Covington**, the PDAs used by the user and the shopper are not directly linked to the computers (28, 32) that are used to access the shopping websites (24, 30), but rather are loaded and used only at a mall or store that is remote from the computer accessing the websites. In contrast to **Covington**, the invention of Applicant has particular usefulness with an on-line directory website, permitting a user to access directory information on the website using his/her

personal computer and directly loading that information into a PDA connected directly to the personal computer. The PDA may then be taken by the user when traveling and used to access the downloaded directory information (e.g., addresses, phone numbers, travel directions, etc.). Such a function and purpose would not be possible with **Covington**, because the PDA in **Covington** is always at a store or mall and is not connected for direct communications with the user's personal computer.

The Examiner also cites **Covington** for its showing of a directory (page 4, paragraph 0069). However, the reference in **Covington** to a "directory" is for a directory or index that is used to electronically access data in the central database 38. It is not an "on-line directory website" as recited by Applicant, which is known to be clearly different (i.e., the directory website as disclosed and defined in Applicant's specification, for example, that lists phone numbers, addresses, maps, driving directions, and so forth.)

The Examiner rejected dependent claim 7 on the basis of **Covington** in view of **Communications Today**, citing the disclosure in **Communications Today** of different display screen formats that may be chosen by users. Claim 7 recites much more than the selection of screen formats. Neither **Covington** nor **Communications Today** show the entire method of claim 7 (including, for example, the elements recited in its parent claims, such as the use of a portable device both at a computer and away from the computer, the use of the computer to access a directory website that provides yellow pages directory listings, as well as other elements recited in its parent claims 22 and 24). Thus, the subject matter of claim 7 is not disclosed, taught, or suggested by **Covington** or **Communications Today**, either alone or as combined by the Examiner.

The other dependent claims (claims 2, 4, 6, 8-12, 24 and 25) are likewise not disclosed, taught, or suggested by **Covington**, **Communications Today** or the other cited references (alone or combined).

The Examiner rejected independent claim 23 on the basis of **Covington** in view of **Reed**. The Examiner cited **Reed** for its disclosure of a yellow pages directory server that may be accessed for on-line information. It is believed that the subject matter of claim 23, including the use of a portable device having one location (whereby it has a direct communication link to a computer for receiving selected information from a yellow pages directory website) and having second, remote locations away from the computer (for being used to access the selected information items at the portable device) is clearly not disclosed in either **Covington** or **Reed**. If anything, **Reed** teaches away from Applicant's invention, since it discloses accessing and communicating with a large, complex database by a consumer computer over the Internet (see, e.g., Fig. 1, and column 12, lines 25-30). The browsers needed for such communication are provided in Applicant's disclosed personal computer 1, but the **Reed** system does not solve the problem of accessing and using on-line directory information at a portable device (e.g., by using Applicant's steps of providing a direct communications link for downloading such information to a portable device, and then using the portable device away from the computer where the information is needed by the user).

Applicant has noted the Examiner's rejection of claim 22 under 35 U.S.C. § 112, second paragraph, for omitting an essential element (i.e., omitting "the computer capable of communicating with the portable device"). Applicant points out that claim 22 previously recited (and continues to recite) "a computer separate from the portable device . . . capable of communicating with the portable device," and thus the Examiner's remarks are not understood. Applicant also points out that amended claim 22 now recites even further details of the relationship between such computer and the portable device. Applicant believes claim 22 (as earlier presented and as now amended) does meet the requirements of 35 U.S.C. § 112, but is more than willing to consider any suggested changes by the Examiner to address the Examiner's concerns should the Examiner continue to believe that claim 22 does not satisfy 35 U.S.C. § 112.

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PATENT

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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